

## **REMARKS**

In the Office Action<sup>1</sup> mailed February 22, 2007, claims 1-6, 8, 10-16, 18, 20-27, 29, 31-37, 39, and 41 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,208,979 to Sinclair ("*Sinclair*"). Claims 9, 19, 30, and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sinclair*. Claims 7, 17, 28, and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sinclair* in view of U.S. Patent No. 6,112,190 to Fletcher et al. ("*Fletcher*"). Applicant notes that independent claim 42 was not addressed by the Office Action.

Applicant has amended claims 1-42 to address minor informalities. No new matter has been added.

Applicant respectfully traverses the rejection of claims 1-6, 8, 10-16, 18, 20-27, 29, 31-37, 39, and 41 under 35 U.S.C. § 102(e) as anticipated by *Sinclair*. In order to properly establish that *Sinclair* anticipates Applicant's claimed invention under 35 U.S.C. § 102(e), each and every element of the claims at issue must be found, either expressly described or under principles of inherency, in *Sinclair*. Furthermore, "[t]he identical invention must be shown in as complete detail as contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

*Sinclair* does not disclose each and every element of Applicant's claimed invention. For example, claim 1 recites a combination including, a "computer based

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

method for automatically creating a list of financing documents for a transaction,” wherein the method includes the step of “requesting a decision criteria document.”

According to the Office Action, *Sinclair* discloses, at col. 7, lines 31-42 and col. 10, lines 30-37, “a computer based system and method for automatically creating a list of financing documents for a transaction,” wherein the method includes the step of “requesting a decision criteria document” (Office Action at p. 2). Applicant respectfully disagrees with the Office Action’s characterization of *Sinclair*.

In particular, col. 7, lines 31-42 of *Sinclair* discloses that “finance institutions create customized electronic model profiles by entering into the System characteristics they judge to be indicative of a ‘desirable’ credit applicant.” For example, in *Sinclair*, qualifiers included in the creation of the electronic model profile might be “the applicant’s gross monthly income, state where dealer is located, number of months the applicant has been employed at present job, number of years the applicant has been residing at present address, and the like.” Thus, the “customized electronic model profile” in *Sinclair* refers to creating profiles, according to characteristics deemed by the “finance institutions” to be indicative of a “desirable” credit applicant.

However, claim 1 recites a step of “requesting a decision criteria document.” Applicant respectfully submits that the “qualifiers” described in *Sinclair*, col. 7, lines 31-42 and col. 10, lines 30-37, are utilized for creating model profiles and not for “requesting a decision criteria document,” as recited in claim 1. *Sinclair* does not disclose or suggest such request.

For at least this reason, the rejection of claim 1 under 35 U.S.C. § 102(e) should be withdrawn. Dependent claims 2-6, 8, and 10-11, which depend from claim 1, are

allowable for at least the same reasons discussed above. Further, these dependent claims may recite unique combinations that are neither taught nor suggested by the prior art. Applicant requests withdrawal of the rejection and allowance of the claims.

Independent claims 12, 22, and 32, although of different scope, recite features similar to those of claim 1. For at least this reason, the rejection of claims 12, 22, and 32 under 35 U.S.C. § 102(e) should be withdrawn. Dependent claims 13-16, 18, 20-21, 23-27, 29, 31, 33-37, 39, and 41 which depend from one of the independent claims, are allowable for at least the same reasons discussed above. Further, these dependent claims may recite unique combinations that are neither taught nor suggested by the prior art. Applicant requests withdrawal of the rejection and allowance of the claims.

Applicant respectfully traverses the rejection of claims 9, 19, 30, and 40 under 35 U.S.C. § 103(a) as being unpatentable over *Sinclair*. Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of these claims because a *prima facie* case of obviousness has not been established with respect to these claims. A *prima facie* case of obviousness has not been established because, among other things, *Sinclair* fails to disclose each and every element of claim 1, from which claim 9 depends. Claims 19, 30, and 40 depend from one of the independent claims, and are allowable for at least the same reasons discussed above.

Applicant respectfully traverses the 35 U.S.C. § 103(a) rejection of claims 7, 17, 28, and 38 as being unpatentable over *Sinclair* in view of *Fletcher*. Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of these claims because a *prima facie* case of obviousness has not been established with respect to these claims.

As discussed above with regard to claim 1, from which claim 7 depends, *Sinclair* does not disclose "computer based method for automatically creating a list of financing documents for a transaction," wherein the method includes the step of "requesting a decision criteria document." *Fletcher* does not cure the deficiencies of *Sinclair*, and, therefore, the rejection of dependent claims 7, 17, 28, and 38 under 35 U.S.C. § 103(a) should be withdrawn.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of claims 1-24.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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